

### **REMARKS/ARGUMENTS**

Claims 1-3 and 6-18 are currently pending. This preliminary amendment is filed with a request for continued examination and addresses comments made in the Examiner's advisory action of January 31, 2008. Further, in view of the Examiner's comments, claims 1, 19, 13, and 15 have been amended to recite that "no more than a portion of" the medical device is received within the cavity of the packaging. Support for this amendment is found explicitly in Fig. 17 and on, at least, page 15 paragraph [0069]. Thus, no new matter is added.

#### **Claim Rejections under 35 U.S.C. §102**

The subject matter of claims 1, 2, 6-9, 11-13 and 15-18 was rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,180,162 to Magney (hereinafter "Magney").

Magney describes a surgical blade dispenser-disposal cartridge that is illustrated in an exemplary manner at col. 3, lines 12-18. The cartridge of Magney completely encloses a surgical blade from the tip of the shank (22) to the tip of the blade (25), as shown in FIGs. 3 and 4 of the reference. The cartridge that Magney describes, therefore, receives the surgical blade fully received therein. During use, the foil cover (18) is removed or breached as the scalpel handle (31) is inserted through the aperture in the end wall (12a) of the cartridge as shown, for example, at col. 4, lines 3-30.

Each of independent claims 1, 9, 13 and 15 recite a "main cap member with a cavity therein" where the cavity is configured to "receive" a "medical device with electrical contacts partially therein so that the electrical contacts project from the cavity opening and minor cap member". As amended, each of these independent claims now recites that "no more than a portion of" the medical device is received within the cavity. As noted in the original specification of this application, the medical device recited in each of the presently presented independent claims is only partially received, so that the medical device's electrical contacts project from the cavity. This arrangement simplifies the engagement of the electrical contacts and the corresponding connector, because there is no need to breach or otherwise remove any component of the medical device package to obtain access to the electrical

contacts. These features are illustrated, at least, in paragraph [0069] and FIG. 17 of the original specification. Since Magney fails to teach, describe, or suggest structure corresponding to this feature present in each independent claim, Magney cannot anticipate any of claims 1, 9, 13, or 15, or any claim depending therefrom. The rejection of claims 1, 2, 6-9, 11-13 and 15-18 under 35 U.S.C. 102(b) is, therefore, respectfully traversed.

Magney does not teach, disclose, or suggest a main cap member with a cavity configured to receive a medical device with electrical contacts partially therein such that the electrical contacts project from the cavity opening and minor cap member. Rather, Magney describes the complete enclosure of a surgical blade (or medical device) by a cartridge. The scalpel handle used to remove the surgical blade from the cartridge is not stored with the surgical blade in the cartridge and therefore is not considered a part of the medical device. The scalpel handle projects from the cavity opening only during use (see, for example, column 4, lines 4-30 and FIGs. 10A- 10C and 11A – 11C of Magney) and not during storage of the surgical blade. If the scalpel handle projected from the cavity opening during storage of the surgical blade, the integrity of the foil cover would be destroyed and sterility of the surgical blade would not be maintained. The scalpel handle also does not serve as an electrical contact for the surgical blade. Thus, Magney does not show structure that corresponds to each element and limitation recited in any of claims 1, 9, 13, or 15. Moreover, since Magney's disclosure is directed to surgical blade cartridges, there is no teaching of the corresponding electrical contacts.

In response to the Examiner's comments in the advisory action of January 31, 2008, Applicants amendment is intended to positively recite structure that, in the Examiner's opinion, was not sufficiently distinguishable from Magney. As amended, the claims set forth structure that is not taught, disclosed, or suggested by Magney or any prior art known to Applicants.

For at least the foregoing reasons, Applicants respectfully submit that independent claims 1, 9, 13 and 15 are not anticipated or obvious over Magney. Since claims 2, 6-8, 11-12 and 16-18 depend from and further limit their respective independent claim 1, 9, 13 or 15

directly or indirectly, they are allowable for at least the same reasons (noting that dependent claims 4 and 5 have been canceled).

Claim Rejections under 35 U.S.C. §103

The subject matter of claim 3 was rejected under 35 U.S.C. §103(a) as obvious over Magney in view of U.S. Patent No. 4,903,390 to Vidal et al. (hereinafter “Vidal”).

Vidal appears to describe an apparatus for removing a surgical blade from a handle (see, for example, col. 4, lines 29-32 of Vidal). The apparatus has a housing that completely receives the blade (see, for example, FIG. 12 of Vidal). Vidal, therefore, does not cure the deficiencies of Magney noted above.

For at least the foregoing reasons, Applicants respectfully submit that the cited combination of Magney and Vidal does not make obvious the subject matter of dependent claim 3 and that claim 3 is, therefore, allowable.

The subject matter of claim 10 was rejected under 35 U.S.C. §103(a) as obvious over Magney in view of U.S. Patent Application Publication 2002/0143352 of Newman et al. (hereinafter “Newman”).

Newman, as understood, describes a shielded surgical scalpel (see, for example, paragraph 0006 of Newman) and was cited for teaching on visual indication arrows. Newman, therefore, does not cure the deficiencies of Magney noted above.

For at least the foregoing reasons, Applicants respectfully submit that the cited combination of Magney and Newman does not make obvious the subject matter of dependent claim 10 and that claim 10 is, therefore, allowable.

The subject matter of claim 14 was rejected under 35 U.S.C. §103(a) as obvious over Magney in view of U.S. Patent Application Publication 2003/0036200 of Charlton (hereinafter “Charlton”).

Charlton appears to describe a sensor pack with a cavity (element 106 of Charlton) that totally encloses a test sensor (element 120 in Charlton). See, for example, paragraph

Serial No. 10/666,154

0024 and FIGs. 3 and 5 of Charlton. Charlton, therefore, does not cure all the deficiencies of Magney noted above.

For at least the foregoing reasons, Applicants respectfully submit that the cited combination of Magney and Charlton does not make obvious the subject matter of dependent claim 14 and that claim 14 is, therefore, allowable.

### **CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance and applicants earnestly solicit early examination on the merits and issuance of a Notice of Allowance. Should the Examiner believe that any additional information or amendment is necessary to place the application in condition for allowance, he is urged to contact the undersigned Attorney via telephone at 484-356-1794 or facsimile number 610-644-8717.

The Commissioner is hereby authorized to charge any required fees due in connection with this submission, including petition and extension of time fees, and to credit any overpayment to Deposit Account No. 10-0750 (Docket No. DDI5016USNP/WJ) (Johnson & Johnson).

Respectfully submitted,

/Wayne Jaeschke, Jr/

Dated: March 17, 2008

By: \_\_\_\_\_  
Wayne C. Jaeschke, Jr.  
Reg. No. 38,503

Johnson & Johnson  
International Patent Law Division  
Attn: Philip Johnson  
P.O. Box 1222  
New Brunswick, NJ 08903  
(484) 356-1794